



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 15

ROBERT NISBETT
311 ANNIVERSARY DRIVE
LONGVIEW, TEXAS 75604

COPY MAILED

DEC 7 1998

In Re Patent No. 5,271,638
Issue Date: December 21, 1993
Application No. 07/930,997
Filed: August 17, 1992
Inventor: Donald M. Yale

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS
ON PETITION

This is a decision on the petition, filed May 12, 1998 under 37 C.F.R. 1.378(b) to accept payment of a maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under C.F.R. 1.378(a) must be filed with TWO MONTHS from the mail date of this decision. No extension of this two-month limit can be granted under 37 C.F.R. 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition see set forth in 37 C.F.R. 1.17(h). After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner of Patents and Trademarks. Any petition for reconsideration accordingly should include an exhaustive attempt to provide any omitted items noted *infra*.

Petitioner filed his application on August 17, 1992. The U.S. Patent and Trademark Office ("PTO") issued U.S. Patent No. 5,271,638 on December 21, 1993. The first maintenance fee could have been paid from December 23, 1996 through June 23, 1997, without a surcharge, or from June 24, 1997 through December 22, 1997 with a surcharge. Because the first maintenance fee was not received within either of the aforementioned periods of time, the patent expired on December 23, 1997. The PTO printed a Maintenance Fee Reminder on July 29, 1997. On May 12, 1998 the petitioner filed the instant petition to accept delayed payment of the maintenance fee so as to reinstate the patent.

A petition to accept an unavoidably delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 C.F.R. 1.378(b) must be accompanied by (1) payment of the required maintenance fee, unless previously submitted; (2) payment of the surcharge set forth in C.F.R. 1.20(l)(1); and (3) a showing that the delay was unavoidable since

reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. In this case, petitioner omits item (3).

Regarding omitted item (3), the Commissioner of Patents and Trademarks ("Commissioner") may accept late payment of a maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. 41(c)(1). A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. 133 because 35 U.S.C. 41(c)(1) uses the identical language, viz., "unavoidable delay." *Ray v. Lehman*, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). A petition to revive cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 35 U.S.C. 133. *Haines v. Quigg*, 673 F. Supp. 314, 316, 5 USPQ 1130, 1131 (N.D. Ind. 1987). An application is "unavoidably" delayed only where a petitioner exercises the diligence "generally used and observed by prudent and careful men in relation to their most important business" in taking all action necessary to respond to an outstanding Office action but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not received timely by the PTO. *In re Mattullah*, 38 App.D.C. 497, 514-15 (D.C. Cir. 1912)(citing *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)).

Petitioner asserts that the delay in payment of the maintenance fees was the result of his having insufficient funds to meet the first maintenance fee payment of \$525. He acknowledges that he knew the rules and statutes about payment of maintenance fees. Further, he acknowledges having received the Maintenance Fee Reminder which was printed July 29, 1997. Consequently, the sole issue is whether or not he has established unavoidable delay caused by an inability to pay the required maintenance fee during the required time period of December 23, 1996 through December 22, 1997.

The current record is inadequate to establish unavoidable delay caused by petitioner's inability to pay timely the first maintenance fee. Mr. Yale states that he did not pay timely the first maintenance fee because he lacked the necessary moneys (¶ 4). He emphasizes that he and his wife are retired and living on only a monthly social security income of only \$1,000. However, Mr. Yale fails to provide a complete statement identifying all of their financial holdings including but not limited to savings accounts, checking accounts, stocks, bonds, and property during the period of time when the first maintenance fee could have been paid, from December 23, 1996 through December 22, 1998. Additionally, the statement by Mr. Nisbett, the attorney, indicates that Mr. Yale was operating a business in which he was manufacturing and selling the patented device (¶ 4). However, no documented showing has been provided by petitioner

concerning the financial records of this business. Copies of the complete financial records of petitioner's company during the period from December 23, 1996 through December 22, 1998 should be provided to substantiate the claim of insufficient money to pay the first maintenance fee.

Because the Petitioner has failed to provide the above showings, the record is inadequate to establish unavoidable delay within the meaning of 37 C.F.R. 1.378(b).

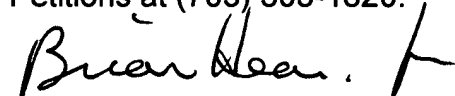
Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commission for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA.

Telephone inquiries related to this decision should be directed to Gary Kunz at (703) 305-9176 or in his absence Special Projects Examiner Brian Hearn at the Office of Petitions at (703) 305-1820.



Abraham HersHKovitz
Director, Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects